

REMARKS

SUMMARY

In the Office Action of December 23, 2003, the Examiner rejected all the claims based on 35 U.S.C. 103(a). Applicant believes that the rejection based on 35 U.S.C. 103(b) should be withdrawn in view of the following Remarks.

REJECTION UNDER 35 USC 103

Hindsight Approach

Applicant objects to the hindsight approach adopted by the Examiner in rejecting the claims. It is well settled law that such an approach is strictly prohibited. After considering Applicant's disclosure, the Examiner has selected two (2) prior art references that are in non-analogous arts and in no way suggest or motivate others to combine features in any way similar to Applicant's invention.

The correct way to resolve the question of obviousness is to follow the approach set forth in Graham v. John Deere, 383 US 1, 17, 148 USPQ 459, 467 (1966). In this case, the U. S. Supreme Court directed that three factual inquiries be made. These factual inquiries are:

1. Determining the scope and content of the prior art.
2. Ascertaining the difference between the prior art and the claims at issue.
3. Resolving the level of skill in the pertinent art.

The Court of Appeals for the Federal Circuit in In re Fritch, 23 USPQ 2d 1780, deals specifically with obvious determinations. In Fritch, the Court on page 1783 states:

"The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification."

As provided in M.P.E.P. Section 2143, before a *prima facie* case of obviousness under 35 USC 103 can be established, the following criteria must be met:

- 1) There must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine the reference teachings;
- 2) There must be a reasonable expectation of success; and
- 3) The prior art references must teach or suggest all the claim limitations.

Applicant believes that the substantial evidence requirement established by In re Kotzab, 217 F. 3d 1365 (Fed. Cir. 2000), is lacking. In re Kotzab states:

A claimed invention is unpatentable if the differences between it and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art. See 35 U.S.C. § 103(a) (Supp. III 1997); In re Dembiczak, 175 F.3d 994, 998, 50 USPQ2d 1614,

1616 (Fed. Cir. 1999). The ultimate determination of whether an invention would have been obvious under 35 U.S.C. § 103(a) is a legal conclusion based on underlying findings of fact. See Dembiczak, 175 F.3d at 998, 50 USPQ2d at 1616. We review the Board's ultimate determination of obviousness de novo. See id. However, we review the Board's underlying factual findings for substantial evidence. See In re Gartside, 203 F.3d 1305, 1316, 53 USPQ2d 1769, 1776 (Fed. Cir. 2000).

The evidence is that Applicant's invention deals with a system and method for distributing **"individual drawings"** that illustrate **"animation"** and the prior art does not even mention **"animate or animation"** and does not deal at all with the distribution of individual drawings **"by mail."**

In re Kotzab further states:

A critical step in analyzing the patentability of claims pursuant to section 103(a) is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. See Dembiczak, 175 F.3d at 999, 50 USPQ2d at 1617. Close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one "to fall victim to the insidious effect of a hindsight syndrome wherein that which only the invention taught is used against its teacher." Id. (quoting W.L. Gore & Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 313 (Fed. Cir. 1983)).

Most if not all inventions arise from a combination of old elements. See In re Rouffet, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457 (Fed. Cir. 1998). Thus, every element of a claimed invention may often be found in the prior art. See id. However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. See id. Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant. See In re Dance, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998); In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). Even when obviousness is based on a single prior art reference, there must be a showing of a suggestion or motivation to modify the teachings of that reference. See B.F. Goodrich Co. v. Aircraft Breaking Sys. Corp., 72 F.3d 1577, 1582, 37 USPQ2d 1314, 1318 (Fed. Cir. 1996).

Scope and Content of Prior Art:

The Examiner relies on: Bratton and Sick et al.

Bratton discloses an internet based viewing system for videos within certain time limits and/or frequencies. The term "viewing" is used by Bratton to include listening and the term "videos" is used by Bratton to include audio recordings. A copyright royalty may be payable and this royalty may at least in part be paid by display of an advertisement contemporaneous with the viewing of the video. The Bratton viewing system facilitates viewing of royalty and non-royalty bearing selections that meets the requirements of the "Digital Millennium Copyright Act of 1998."

Sick et al discloses an internet based system for selling commodities, including an auctioning feature. User data and information may be gathered. It allows a user to plan and control consumption of the commodities.

Differences between Prior Art and Claims:

The Examiner rejects Claims 1, 3, 4, 7, 11, 13, 14, 23, 25, 26 as being obvious in view of Bratton, which he characterizes as a system for distributing "visual art." He acknowledges, however, that Bratton does not disclose distributing a drawing to a mailing address. The Examiner does take the position that a video "can be considered a continuous flow of individual drawings" and, apparently, that an electronic storage facility is the same as a mailing address.

The Examiner rejects Claims 2, 5, 6-8, 12, 15-22 and 24 as being obvious in view of the combination of Bratton and Sick et al. The Examiner

acknowledges that Bratton does not enable a buyer to select a time interval at which individual items are delivered to a buyer, but relies on Sick et al as a teaching of enabling a buyer "to select a time period in which to compare rates" for purchasing energy.

For the Examiner to declare that a video "can be considered a continuous flow of individual drawings" misses the point of Applicant's invention. A video may be, but does not necessarily have to be in whole or part, an animation. Applicant's invention is a vehicle for instructing children how cartoon characters are animated in movies. In Applicant's invention one or more drawings are provided as individual works, not as a stream of drawings constituting an animated video.

As Claim 1 recites, Applicant's invention provides a buyer with one individual drawing of "one subject from a plurality of different subjects for drawings" ordered over a web site and delivered by mail. A series of individual, separate but related, drawings may be delivered by mail over time. The drawing the buyer selects may be an imaginary pet, an idea that is especially appealing to children. The individual drawings purchased over time comprise series of drawing that may show how the pet grows. These individual drawings may be delivered in a folder with information about the pet to add interest and provide a sense of ownership. These drawings are hand-painted works of art and are not equivalent to videos. Simply put, Applicant's invention has noting to do with distribution of videos. It has everything to do with distribution of individual drawings in a manner that illustrate how animation works.

Since Applicant's invention has such a different purpose than that of the inventions of Bratton and Sick et al, very significant features of Applicant's invention are not present or suggested by the teaching of Bratton and Sick et al. For example, in Bratton the video may be downloaded electronically if an appropriate payment is made. In contrast, in one embodiment of Applicant's invention, the drawing is non-digitized, hand-drawn and must be mailed as a hardcopy. Consequently, as an original work of art it has enhanced value. The Examiner in his comments disregards or discounts this important difference.

In one embodiment of Applicant's invention, a series of individual drawings of the subject selected by the buyer are mailed over a time interval. This gives the buyer, particularly children, a sense of the subject changing over time, for example, a pet growing up such a puppy becoming a full grown dog. For example, Claims 4 and 11 state:

"...the drawings comprises a series of individual drawings of the subject in a predetermined sequence where, from one individual drawing to the next in the sequence, the subject changes in size or position so that, when the series of individual drawings are viewed rapidly one after the other in said sequence, the subject appears to change shaped or move in an animated manner..."

And, for example, Claims 9, 16, 18, and 23 state:

"... at least one drawing is an original hand-painted work of art on a transparent film..."

And, for example, Claims 7, 14, 20, 26 state:

"...an individual drawing is delivered in a folder that holds the individual drawing and provides information about the selected subject..."

Both Bratton and Sick et al are non-analogous art. They both fail to suggest or motivate one skilled in the art of "teaching how animation works" to make the combination of features set for in Applicant's original claims. Applicant's invention is a positive influence on children. It promotes an appreciation of art, in particular animation art, which can be collected and displayed. Instead of action toys or games fostering violence, it teaches a child to be patient and observed the natural progression of life. Using hindsight, the Examiner combines these non-analogous references, notwithstanding that there is nothing in either of them to suggest a system and method for distributing drawings that illustrate animation, and concludes that Applicant's invention is obvious. This is clearly an erroneous application of the standard of 35 USC 103(a) contrary to the mandate of Graham v. John Deere.

Level of Skill in the Pertinent Art:

One way to ascertain the level of skill in the pertinent art is to examine the references cited. None of these references in any way suggest Applicant's invention as defined by the **original** claims. This is indicative of the skill in the art to which Applicant's invention is related.

In view of the above **Remarks**, the application is deemed to be in a condition for allowance and such action is solicited.



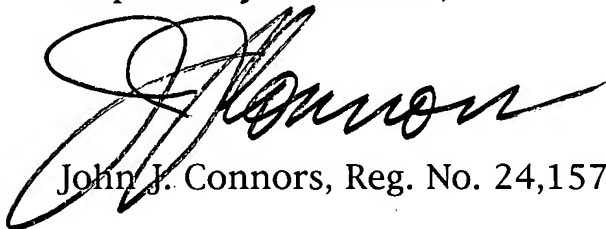
TELEPHONE INTERVIEW

If the Examiner believes that a telephone interview would advance the allowance of this application, Applicant's attorney requests the Examiner call to arrange a date and time for such interview after having an opportunity to review the above amendments and consider the above remarks.

CUSTOMER NUMBER

Please note Applicant's attorney Customer No. 021905, and confirm that this customer number has been entered in the U. S. Patent & Trademark Office records in connection with the above-identified application.

Respectfully submitted,



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